

REMARKS

Claims 1-4, 6-23 and 26-37 are all the claims pending in the application.

This is an Amendment in response to the Office Action mailed February 6, 2006. It follows an Examiner Interview on June 21, 2006 in sister application 10/721,385.

In the Office Action in this application, all pending claims were rejected under the doctrine of double patenting and as being obvious over the teachings of primary reference Banks in combination with Baumgartner, Marshak, Kameraman and/or Vin. These rejections are similar to those in sister application 10/721,385. Accordingly, the discussions in the June 21 Interview have relevance to this application as well.

At the Interview consensus could not be reached over the meaning of the word "location" in the claims and, accordingly, whether the Banks taught the claimed service record that included the user's location. The Examiner did, however, indicate that prior art did not teach registering a communication device's service capabilities. Accordingly, Applicants are amending the independent claims to incorporate this concept.

The Examiner also requested certain other amendments. In response, Applicants are making additional amendments to the claims. Applicants have also made additional claim broadening amendments by removing unnecessary limiting words.

In this Response Amendment, therefore, all independent claims are amended, certain dependent claims are also amended and one claim is cancelled without prejudice. In addition, a Terminal Disclaimer is being filed herewith.

As will be apparent from the comments below, these amendments and the filing of the Terminal Disclaimer are being made in an effort to obtain expeditious allowance and not because Applicants accept the rejections in the Office Action or the Examiner's positions expressed in the Interview.

A brief discussion follows.

EXAMINER'S INTERVIEW

As a preliminary matter, Applicants and their representative, Craig Opperman, wish to thank the Examiner for the courtesy extended during the June 21, 2006 Examiner Interview in sister application 10/721,385. Despite the lack of consensus, Applicants appreciate the Examiner's well-articulated position, the constructive discussion and suggestions on moving this application towards allowance.

In summary, at the Interview there were different interpretations of the meaning of the word "location" and, accordingly, whether primary reference Banks taught a service record that contains a user's location. Applicants asserted that it did not, while the Examiner -- in interpreting the claim in its broadest sense -- countered that the term "location" encompasses a "virtual" location and thus read on to Banks' technology.

Alternatives to this interpretation difference were explored. These were very fruitful and it was suggested that amending the claims to require registering user's communication device's capabilities would avoid the prior art of record.

In addition, the Examiner requested removal of the phrase "no matter where the user is located" from the claims in the sister application.

Finally, the filing of a Terminal Disclaimer was discussed.

OFFICE ACTION REJECTIONS

CLAIM REJECTIONS BASED ON DOUBLE PATENTING

The Office Action has rejected the claims based on a judicially created doctrine of double patenting as follows:

Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of Application No. 10/722,051; claims 1-42 of Application 10/721,905; and claims 1-42 of Application 10/721,385. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially equivalent limitations or

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obvious variation thereof. This is a provisional rejection because the claims are not in fact patented.

Applicants' representatives are filing a Terminal Disclaimer with this Response Amendment, thus making moot this rejection.

CLAIM REJECTIONS - 35 USC § 103(a)

The Office Action also rejected the claims under 35 U.S.C. 103 as follows:

“Claims 1-4, 6-23, 26-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael Banks "America Online: A Graphics Based Success Evaluation", and further in view of Baumgartner et al. US patent 5,195,086, and Marshak "Beyond Mail for Windows" and Kameraman et al. US patent 5,519,834, Vin et al. "Multimedia Conferencing in the Etherphone Environment".

In summary, the Office Action relies on Banks to teach a service record that includes information regarding a user's location. The Office Action then relies on Baumgartner to teach “the usage of graphical icon representing users” to be called, and Marshak to teach private and global directories. In rejecting the dependant claims, the Office Action piles on Kameraman to teach wireless communications and Vin for automatically notifying users of an incoming call. Various arguments are put forth as to why it would be obvious to combine three or more of these disparate references to create the claimed invention.

APPLICANTS' RESPONSE TO THE § 103 REJECTIONS

In response, Appellants submit these rejections cannot be sustained for a number of reasons, the primary one being that the combined references simply do not teach all claim elements. For example, neither Banks nor any other references teach a service record that includes user login location information.

Further, Applicants submit that it is improper and cannot be shown to be obvious to combine the references as suggested.

But, because the references are deficient in their teaching and Applicants have amended the claims per the Examiner's suggestions, any discussion on obviousness to combine is rendered moot. Thus, Applicants do not address the other obviousness rejections or the rejections of the dependant claims.

Turning now to the Office Action's contention that Banks teaches a record of a user's location:

The February 6, 2006 Office Action argues that Banks' system "discloses at least one service record including... associated location where the user is logged-in no matter where they are located (page 3, 1st paragraph see "where a member is from").¹

But, inspection reveals that this quoted section does not teach maintaining information about a user's login location at all. The "where a member is from" language in Banks refers to demographic information. It is the town, state or other geographic place from which the member hails, not the member's log-in location. In fact a member could quite possibly be logged-in at a place very different than "where the member is from."

Obviously, this is not the location where the user is logged-in as claimed. Indeed, at an interview on April 11, 2006, Examiner Dinh appeared to agree with this specific point. So too did Examiner Reilly at the June 21, 2006 interview in the sister application.

Accordingly, Applicants believe that the Office Action does not demonstrate all the claim limitations and thus all independent claims should be allowed.

AMENDMENTS

Despite their belief that the claims are allowable, Applicant's have amended the claims based on a suggestion by the Examiner in the Interview of the sister application.

Specifically:

¹ Office Action dated February 6, 2006.

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The independent claims have been amended to add a limitation to a user's communication device's service capabilities being registered. This aspect is supported by the teaching in at least paragraph [0134] and [0282] in the pre-grant publication 2004/103,152.

The phrase "no matter where the user is located" has been deleted from independent claims 1 and 29 in response to the Examiner's request in the sister application. This request also necessitated canceling claim 17.

New dependent claims have also been added.

Other amendments have also been made to clarify and/or improve the claims and, in certain instances, broaden them by removing unnecessary limitations.

Because both Applicants and the Examiner believe that the prior art does not teach this added "registering capabilities" limitation, the independent claims are believed allowable. The dependant claims are therefore also allowable.

CONCLUSION

In summary, all the claims contain at least one limitation that is neither taught by, inherent in nor obvious from Banks alone or in combination with the cited prior art.

Applicants accordingly respectfully submit that all of the pending claims define subject matter that is patentable over the prior art. Their immediate allowance is respectfully requested as soon as possible.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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